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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/625,366 | 07/23/2003 | Tushar V. Choudhary | | 8227 |

7590

04/27/2006

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| EXAMINER |
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NGUYEN, CAM N

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| ART UNIT | PAPER NUMBER |
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1754

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/625,366 | Applicant(s) CHOUDHARY ET AL. | |
| | Examiner Cam N. Nguyen | Art Unit 1754 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/10/06 (an amendment/response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 37-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' amendment and remarks, filed February 10, 2006, has been made of record and entered. Claims 1 & 16 have been amended.

Claims 1-56 are currently pending.

Status of Withdrawn Claim(s)

2. Claims 37-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 26, 2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 & 16-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sughrue et al., "hereinafter Sughrue", (US Pat. 6,254,766).

Sughrue discloses a process for the production of a sorbent composition which

comprises: (a) admixing of zinc oxide, silica and alumina so as to form a mix thereof...; (b) particulating the resulting mix so as to form particles thereof; (c) drying the particulate of step (b); (d) calcining the dried particulate of step (c); (e) impregnating the resulting calcined particulate of step (d) with nickel or a nickel-containing compound; (f) drying the impregnated particulate of step (e); (g) calcining the dried particulate of step (f); and thereafter (h) reducing the resulting calcined particulate of step (g), etc. (see col. 14, claim 7). The mix is in the form of one of a wet mix, dough, part or slurry (see col. 14, claim 8). The particles are in the form of one of granules, extrudates, tablets, pellets, or micropores (see col. 14, claim 9). The claimed process conditions are fully disclosed at col. 14, claim 11 & claim 12).

While Sughrue does not disclose including a promoter (or nickel) in the admixing step (a), it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have added such promoter to the mixture in the admixing step (a) of Sughrue in order to achieve a promoted and effective catalyst composition, and in view of step (e) of the reference which teaches to impregnate the resulting calcined particulate with nickel (see Sughrue at col. 14, claim 7).

Applicants claiming step (e), which is "recovering said composition" is noted. It is considered the inclusion of this recovering step in the process of Sughrue is inherent in order to collect the most out of the final product resulted from the process.

Claim Rejections - 35 USC § 102(b)/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15 & 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sughrue et al., “hereinafter Sughrue”, (US Pat. 6,254,766).

Sughrue discloses the claimed composition (see above).

Product-by-process limitations in the claims are noted. It is considered that while the composition is not made by the same process, the composition made is the same as being claimed. Thus, the process limitations in the claims have no bearing on the patentability of the claimed product per se. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also MPEP 2113.

Response to Applicants' Arguments

7. Applicants' amendment and remarks filed on February 10, 2006 has been reconsidered, but not deemed persuasive in view of the new ground of rejections above.

Conclusion

8. Claims 1-56 are pending in the application. Claims 1-36 are rejected. Claims 37-56 remain withdrawn due to nonelected (distinct) invention. No claims are allowed.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn
April 21, 2006


CAM N. NGUYEN
PRIMARY EXAMINER

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